

REMARKS

In the present application, claims 24-26, 32-35 and 39-51 are pending. Presently, all claims are objected to for being indefinite or rejected for being obvious over the prior art. The Examiner has additionally suggested amendments to the specification constitute new matter.

In view of the following remarks and present amendments, Applicant respectfully requests reconsideration and allowance of the application.

Rejection Under 35 U.S.C. § 112**Introduction of New Matter: Adhesives**

The Examiner, in paragraph 3 on page 2 of the Final Office Action (there exist two paragraph 3s in the Final Office Action—one on page 2 of the Final Office Action and a second on page 3) states that revisions made to the specification in the applicant's amendment dated January 21, 2004, constitute prohibited "new matter." The Examiner points to applicant's amendments in the specification as they pertain to "applying water," "providing static electricity" and "applying a [sic] pressure" as evidence of the introduction of new matter. The Examiner alleges these amendments "lack any express, and it is believed inherent, support in the specification." Applicant respectfully traverses.

The application incorporates, by reference, the disclosure of no less than seven patents and applications. The various disclosures set forth more than adequate support the amendments made to the specification in the amendment dated January 21, 2004. For example, incorporated U.S. Patent No. 6,237,269 to the applicant—Stephen M. Key—at col. 6, l. 51-55 discloses various adhesive techniques: "a blast of air of gas against the leading end, moisture applied to the leading end, vacuum pressure, and static electric charge pressure" (emphasis added). Moisture is exemplified as "a small amount of

"water" at col. 6, l. 1-2 (emphasis added). The '269 Key patent also discloses the use of a "hold or pressing apparatus" at col. 6, l. 6-7 wherein pressure would be applied.

Notwithstanding the knowledge of one skilled in the art of adhesive application—knowledge explicitly recognized by the Examiner in Paragraph 5 of the Final Office Action—and, further, as to applying water, static and pressure, the incorporated teaching of, at least, the '269 patent to Key provides support for the amendments made to the specification. As such, applicant contends the Examiner's new matter rejection as it pertains to "applying water," "providing static electricity" and "applying a [sic] pressure" is overcome.

Introduction of New Matter: Coupling

The Examiner, again in paragraph 3 of page 2 of the Final Office Action, asserts "the substitution throughout both the specification and the claims of the word 'coupling' is believed to possibly be also be new matter." Applicants, respectfully, traverses.

Coupling is well known in the art to be construed as "means for joining two parts." Winther v. Winslow 120 USPQ 452, 454 (P.O. Bd. Int. Exrs 1958). As such, it is not necessary to rehash skills or processes that, in the relevant field, are already well known. See Webster Loom Co. v. Higgins 105 U.S. 580 (1882). And "[t]hat which is common and well known is as if it were written out in the patent and delineated in the drawings." Id. at 586. As such, applicant contends its amendments as to coupling—a well known skill in the art thereby writing that knowledge into the application—cannot be construed as new matter.

Furthermore, and again returning to the incorporated '269 Key patent, claims 5, 18 and 30, for example, explicitly disclose the concept of "coupling," specifically—"temporary coupling." The specification of the '269 Key patent at col. 5 1.61-col. 6 l. 13, in turn, inherently discloses coupling—means for joining two parts—with regard to its discussion of holding (joining) a label against a container (two parts).

As the incorporated teaching of, at least, the '269 patent to Key and the knowledge of those skilled in the art provides support for the amendments made to the specification, applicant contends the Examiner's new matter rejection as it pertains to "coupling" is overcome.

Lack of Written Description

The Examiner rejects claims 24-26, 32-35 and 39-51 under 35 U.S.C. § 112, ¶ 1 as "failing to contain a written description of the invention." The Examiner, in support of the asserted failure to provide an adequate written description, states the applicant "can only supply a single solitary example of what constitutes a 'temporary adhesive' and also a 'permanent adhesive'" and concludes this to evidence insufficient support for the claim.

The Examiner's rejection is, initially, believed to be moot as nowhere in the amended claims does there exist the terminology "temporary adhesive" or "permanent adhesive." While certain claims are directed toward the use of an adhesive for temporarily securing a label or, in the alternative, permanently securing a label, this is not the basis of the Examiner's rejection. As such, the rejection should be withdrawn. In the alternative, the applicant again traverses the Examiners rejection.

Paragraph 2 of the Detailed Description section of the application is replete with examples of adhesives, both temporary and permanent. For example, the specification identifies "glue droplets or dots" as examples of a permanent adhesive. Alternatively, the specification identifies "water," "static electricity" and the application of "pressure" as examples of means to temporarily adhere the surface of a label to a second surface. The aforementioned and incorporated '269 patent to Key along with the disclosure of six other patents and applications—all incorporated by reference—provide examples of varying adhesives.

The Examiner is respectfully requested to note that 35 U.S.C § 112, ¶ 1 "requires nothing more than objective enablement. How such a teaching is set forth, either by broad use of illustrative examples or by broad terminology, is of no importance." In re Marzocchi 439 F.2d 220, 223, 169 USPQ 367 (C.C.P.A. 1971) (emphasis added). In light of Marzocchi, it is "a matter of Patent Office practice" that:

a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support

Id.

As the Examiner, in the non-final Office Action of October 21, 2003 (Paper No. 0909), finds the two terms—temporary and permanent adhesive—to be "known in the art," he cannot then assert there to exist a doubt as to the objective meaning of temporary and permanent adhesive. In light of having posited both broad terminology and specific examples as provided by Marzocchi, applicant respectfully contends the rejection has been overcome as is the Examiner's 35 U.S.C. § 112 rejection in Paragraph 4 of the Final Office Action based on a defective specification.

Rejections Under 35 U.S.C. §103

In paragraph 5 of the Final Office Action, the Examiner rejected claims 24-26, 32-35 and 39-51 as being unpatentable over Barnum, Jr. (U.S. Patent No. 2,860,431) taken either individually, or in view of either of Ingle (U.S. Patent No. 4,727,667), Fumei (U.S. Patent No. 4,567,681) or Haines (U.S. Patent No. 4,312,523).

The Examiner initially rejected all pending claims under 35 U.S.C. § 103 in the Office Action (Paper No. 0909) dated October 21, 2004 "as being unpatentable over either Ingle, Fumei or Haines." Applicant traversed the rejection and noted "[e]ach of the prior references discloses a label which is affixed, and not rotatable, about the container" (emphasis added). Applicant then proceeded to distinguish each of the cited references from Applicant's claimed invention.

The Examiner, in his Final Office Action, conceded as much noting, "the fact that these labels [in the cited references] are not rotatable" (emphasis added). The Examiner, in recognition of the limitations of the Ingle, Fumei and Haines references, proceeded to introduce a new reference—Barnum, Jr.—asserting it to disclose:

a container having both an inner label glued or pasted to the container and on the inner label's outer surface an outer label 21 which can be both transparent and also rotatable so as to be capable of viewing the pictures or other printed literature set forth on the outer surface of the inner label.

The Examiner then noted that while Barnum, Jr. "fails to disclose the relatively straightforward bonding arrangements found in applicant's claims," he "believe[s those arrangements are] within the skills of the art." Alternatively, the Examiner suggests Ingle, Fumei and Haines "clearly teach the relied upon adhesive bonding patterns which have more than one sort of adhesive bonding section" and, in conjunction with Barnum, Jr., would thereby read upon Applicant's claims.

Barnum, Jr.—by itself—does not provide a proper basis for a 35 U.S.C. § 103 rejection in that Barnum, Jr. does not teach the temporary coupling of an outer label to an inner label and subsequently removing the coupling to permit the outer label to rotate about the inner label. Similarly, combining Barnum, Jr. with Ingle, Fumei or Haines does nothing more than add the teaching of a bonding agent; the combination still fails to teach temporary coupling and subsequent removal of the coupling to provide for rotation of the outer label.

Even if such a combination were to produce the teachings alleged by the Examiner—and the Applicant contends they do not—it remains necessary to ascertain whether or not the reference teachings appear to be sufficient for one of ordinary skill in the relevant art, having the reference before him, to make the proposed combination. See In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560 (CCPA 1972). Applicant respectfully contends there is no suggestion to combine the freely rotating sleeve of Barnum, Jr. with the affixing agents of Ingle, Fumei and Haines; the Examiner provides no basis for the proposed combination beyond a mere "belie[f] one of ordinary skill in the art" would make such a combination.

The Examiner's belief, standing alone, hints of "hindsight analysis and rote application of the legal test for obviousness." In re Rouffet, 149 F.3d 1356, 1358, 47 U.S.P.Q.2d 1453 (Fed.Cir. 1998). Failure to "explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one . . . to make the combination" leads to an inference of selecting references "with the assistance of hindsight." Id. (emphasis added). The Federal Circuit has expressly forbidden "the use of hindsight in the selection of references that comprise the case of obviousness." Id. (citing In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885 (Fed.Cir. 1991)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed.Cir. 1992). Applicant contends the lack of explanation as to a specific understanding of the motivation to combine much less a suggestion as to the desirability of the combination of Barnum, Jr. with Ingle, Fumei and Haines should result in the withdrawal of the Examiner's 35 U.S.C. § 103 rejection.

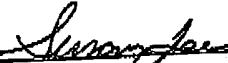
CONCLUSION

Based on the foregoing remarks, Applicant believes that the objections and rejections in the Office Action are fully overcome and that the application is in condition for allowance. If the Examiner has any questions regarding the case, the Examiner is invited to contact Applicant's undersigned representative.

Respectfully submitted,
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